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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/592,660	06/13/2000	Neil W. Black	03797.86776	7450

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EXAMINER

POINVIL, FRANTZY

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/592,660

Applicant(s)

BLACK ET AL.

Examiner

Frantzy Poinvil

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11, 17-28 and 30-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 17-28 and 30-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. The Affidavit under Rule 131 and the Affidavit filed under Rule 132 filed on 9/28/2004 have been received and acknowledged.

2. This action is in response to the Affidavits filed on 9/28/2004.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 5, 7, 10, 11, 17-18, 21, 23, 26-28, 30, 32-33, 34 and 36-48 are rejected under 35 U.S.C. 102(e) as being anticipated by Ray et al. (US Patent No. 6,018,722).

As per claims 1 and 17, Ray et al disclose all the claimed invention particularly, a computer-implemented method for creating a portfolio comprising:

Receiving computer input identifying specific issues to be added to the portfolio (column 5, lines 1-18 and lines 40-58);

Receiving computer input indicating a selection of one of a plurality of options for creating the portfolio (column 5, lines 1-18 and lines 40-58);

Receiving computer-input indicating a past date for purchase of the portfolio; and

Creating the portfolio and calculating the portfolio's past performance, using a computer based on said selection of one of said plurality of options and the past date.

Applicant is directed to column 5, lines 40-58, column 7, lines 15-21 and column 4, lines 52-55 of Ray et al..

As per claims 2 and 18, Ray et al disclose receiving computer input indicating the selection includes receiving computer input indicating a selection of an option to allocate a number of shares for each issue. See column 5, lines 9-18, lines 44-48 and 55-58 of Ray et al..

As per claims 5, 10 and 21 and 26, the number of shares for each issue is based on a weighting factor as calculated by the system of Ray et al. See column 5, lines 4-9 and column 6, lines 4-10 of Ray et al.

As per claims 7 and 23, Ray et al disclose said receiving computer input indicating the selection includes receiving computer input indicating a selection of an option to allocate a total amount for the portfolio. See column 5, lines 9-58; column 7, lines 15-20 and column 8, lines 54-62 of Ray et al.

As per claims 11 and 27, Ray et al disclose providing a historical purchase price for each for each specific issue in the portfolio is obtained by the computer from a historical database based on the past date. Note column 2, lines 25-39, column 4, lines 9-16 and 53-55 and column 11, lines 13-37 and column 8, lines 1-2 of Ray et al.

As per claim 28, Ray et al disclose a system for creating a portfolio of issues comprising:

An input system for receiving a designation of issues, for receiving a designation of an option fro creating the portfolio selected from a plurality of options, and receiving a historical price associated with each of said issues;

And a processor for determining the number of shares of the issues to add to the portfolio and past performance data relating to the portfolio based on the designated option and the historical price.

As per these features, applicant is directed to column 2, lines 25-39, column 4, lines 9-16 and 53-55 and column 11, lines 13-37 of Ray et al.

As per claims 30 and 34, Ray et al disclose a computer readable medium having a computer-executable program stored thereon for creating a portfolio of issues, the program comprising the steps of:

Receiving identification of specific issues to be added to the portfolio;

Receiving identification of past closing date for the issue;

Receiving historical prices for the specific issues based on the past closing date;

Receiving a selection of a quantity of said specific issues and

Creating the portfolio based on the specific issues, the selected quantity of the specific issues and the historical prices.

As per these features, applicant is directed to column 2, lines 25-39, column 4, lines 9-16 and 53-55 and column 11, lines 13-37 of Ray et al.

As per claims 31 and 35, Ray et al disclose storing the portfolio on a client computer.  
See figure 2 and column 4, lines 16-47 of Ray et al.

As per claims 32 and 36, the computer-readable medium stores the portfolio on a server computer. See figure 2 and column 4, lines 16-47 of Ray et al.

As per claim 33 and 37, Ray et al disclose receiving information regarding the specific issues. See column 4, lines 12-61.

As per claims 38-48, Ray et al disclose a computer-implemented method and a computer readable medium for creating a portfolio or issues as claimed. Applicant is directed to figure 2 and column 4, lines 16-47 of Ray et al.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-4, 6, 8-9, 19-20, 22 and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ray et al (US Patent No. 6,018,722).

As per claims 3-4, 6 and 19-20 and 22, the teachings of Ray et al are discussed above.  
Ray et al do not explicitly teach whether the number of shares is constant or not constant for each

issue or allocating an equal amount of the purchase of each issue wherein the equal amount is selectable by a user. However, the Examiner notes that such would have been left to the user or investor. Thus, providing such a feature in the system of Ray et al would have been obvious to one of ordinary skill in the art in order to place a desired quantity of shares in the portfolio for each issue when placing a complete order.

As per claims 8-9 and 24-25, Ray et al disclose calculating a limit amount having an indication of a selection of an options to allocate in a portfolio. See column 5, lines 5-58 of Ray et al. Ray et al do not explicitly teach the amount is equally divided between the issues or the amount is not equally divided between the issues. It would have been obvious to one of ordinary skill in the art at the time the invention was made to divide the amount equally or unequally between the issues in the system of Ray et al. as such would have been dependent on the user when placing an order.

### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (703) 305-9779. The examiner can normally be reached on Monday-Thursday 7:00AM-5:30PM.


The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

FP

November 8, 2004

  
FRANTZY POINVIL  
PRIMARY EXAMINER  
AU 3628